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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,993	10/15/2001	Sumio Iwase	09812.0443	4325
22852 7590 09/02/2010 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER CHANDLER, SARA M				
ART UNIT		PAPER NUMBER		
3693				
MAIL DATE		DELIVERY MODE		
09/02/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/869,993

**Applicant(s)**

IWASE, SUMIO

**Examiner**

SARA CHANDLER

**Art Unit**

3693

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

This Office Action is responsive to the Applicant's arguments regarding the election/restriction (04/13/10) filed on 07/13/10. Please note the lack of unity described below.

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-6, drawn to an auction system for carrying out an auction in a network to which a plurality of nodes are connected..
- II. Claims 7-10, drawn to an auction processing method for hosting an auction in a network to which a plurality of nodes are connected.
- III. Claims 11-18, drawn to an auction processing apparatus connected to a network to which a plurality of nodes are connected, receiving a bid transmitted from any node via said network, and hosting the auction of a desired product.

- IV. Claims 19, drawn to an auction processing method for receiving a bid transmitted from any node via a network and hosting an auction of a desired product in an apparatus connected to a network to which a plurality of nodes are connected.
- V. Claims 20-21, drawn to an auction processing apparatus for submitting a product for auction to a system disclosing information describing products and hosting auctions with respect to the products on a network to which a plurality of nodes are connected.
- VI. Claims 22-23, drawn to 22. An auction processing method for submitting a product for auction to a system disclosing information describing products and hosting auctions for related products on a network to which a plurality of nodes are connected.
- VII. Claims 24-34, drawn to an auction system for hosting auctions in a network to which a plurality of nodes are connected..
- VIII. Claims 35-41, drawn to an auction processing method for hosting an auction in a network to which a plurality of nodes are connected.
- IX. Claims 42-50, drawn to an auction processing apparatus having a shipping information requesting means connected to a network to which a plurality of nodes are connected.

- X. Claims 51 and 52, drawn to an auction processing apparatus/method connected to a network to which a plurality of nodes are connected and hosting an auction of any product.
- XI. Claims 53-57, drawn to an information processing system.
- XII. Claims 58-62, drawn to a second step of raising a suit with respect to said service by transmitting petition information to a trial processing side

The inventions do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity of invention exists when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding technical features. Lack of unity may be demonstrated *a priori*, before consideration of the prior art in relation to the claims. Lack of unity *a priori* occurs when there are no technical feature(s) that are common to all the claims. Lack of unity may also be demonstrated *a posteriori*, after consideration of the prior art in relation to the claims. Lack of unity *a posteriori* occurs when the claims have common technical feature(s) however, these features do not represent applicant's contribution over the prior art. **See also MPEP § 1850, II.**

**Determination of "Unity of Invention"; and MPEP § 1893.03(d).**

**37 CFR 1.499. Unity of invention during the national stage**

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require that the applicant in the response to that action elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. MPEP § 1893.03(d).

**Groups I - XII** lack unity of invention *a priori* because there are no technical feature(s) that are common to all of the claims.

**Groups I and II; I and III; I and IV; I and V; I and VI; I and VII; I and VIII; I and IX; I and X; I and XI; I and XII:** Group I comprises technical features such as a submitting node for transmitting information describing a product and information including sale conditions to a sponsor node for any product and submitting the product in the auction. None of the technical features are common to or shared with the technical features found in Groups II – XII.

**Groups II and III; II and IV; II and V; II and VI; II and VII; II and VIII; II and IX; II and X; II and XI; II and XII:** Group II comprises technical features such as a submitting node transmits information describing a product, information of sale conditions, and information indicating whether or not the product is to be submitted for auction again if a transaction fails to be established to an auction sponsor node for the product to be submitted, the sponsor node changes part or all of the content of said disclosure relating to the product and said sale conditions for a product failing in establishment of a transaction and for which an instruction for submitting the same for auction again was given and includes the same as a product for auction again. None of the technical features are common to or shared with the technical features found in Groups III – XII.

**Groups III and IV; III and V; III and VI; III and VII; III and VIII; III and IX; III and X; III and XI; III and XII:** Group III comprises technical features such as an auction receiving means for receiving an application for auction for any product including information describing the product and information of sale conditions of the product and including the product as a product for auction, a successful bid determining means for determining a purchaser of the product from applications for purchase received within a predetermined period for said product for auction and having purchase conditions of the application matching with said sale conditions of the product, and a re-auction means for changing part or all of said sale conditions and said information describing the product to be disclosed according to a predetermined process for a product for which a purchaser could not be determined and including the product as a product for auction again. None of the technical features are common to or shared with the technical features found in Groups IV – XII.

**Groups IV and V; IV and VI; IV and VII; IV and VIII; IV and IX; IV and X; IV and XI; IV and XII:** Group IV comprises technical features such as receiving an application for auction for any product including information describing the product and information of sale conditions of the product and including the product as a product for auction, determining a purchaser of the product from applications for purchase received within a predetermined period for said product for auction and having purchase conditions of the applications matching with said sale conditions of the product, changing part or all of said sale conditions and said information describing the product to be disclosed according to a predetermined process for a product for which said

purchaser could not be determined and including the product as a product for auction again. None of the technical features are common to or shared with the technical features found in Groups V – XII.

**Groups V and VI; V and VII; V and VIII; V and IX; V and X; V and XI; V and XII:** Group V comprises technical features such as an auction applying means for transmitting information describing a related product including information describing said product to be disclosed, said sale conditions of the product, and said instruction relating to re-auction for a product for submission to said node receiving auctions. None of the technical features are common to or shared with the technical features found in Groups VI – XII.

**Groups VI and VII; VI and VIII; VI and IX; VI and X; VI and XI; VI and XII:** Group VI comprises technical features such as generating an application for auction for any product including information describing a product, sale conditions of the product, and an instruction for automatically changing part or all of said information describing the product to be disclosed and said sale conditions and instructing whether or not the product is to be submitted for auction again when a transaction was not established in the auction and transmitting said generated application for auction to said node receiving auctions on said network. None of the technical features are common to or shared with the technical features found in Groups VII – XII.

**Groups VII and VIII; VII and IX; VII and X; VII and XI; VII and XII:** Group VII comprises technical features such as an auction sponsoring means comprised on any



node of said network, disclosing the submitted product by a format enabling viewing from any node on said network, receiving a bid from a bidding means on any node, determining the successful bidder for selling the product to from the bidding means placing bids, and transmitting information relating to shipping of said product to said submitting means and said successful bidder. None of the technical features are common to or shared with the technical features found in Groups VIII – XII.

**Groups VIII and IX; VIII and X; VIII and XI; VIII and XII:** Group VIII comprises technical features such as determining a successful bidder for selling the product to from received bids, and transmitting information relating to said successful bid and information relating to shipping of the product to a submitter of the product and successful bidder. None of the technical features are common to or shared with the technical features found in Groups IX – XII.

**Groups IX and X; IX and XI; IX and XII:** Group IX comprises technical features such as transmitting information of the result of a successful bid of an auction to a shipping arranging means on any node on the network and requesting information relating to shipping of the successfully bid product from a submitter to a successful bidder. None of the technical features are common to or shared with the technical features found in Groups X – XII.

**Groups X and XI; X and XII :** Group X comprises technical features such as acquiring information relating to the shipping of the successfully bid product from the submitter to the successful bidder based on the result of said successful bid, and

transmitting the information of the result of said successful bid and said information relating to shipping to said submitter and successful bidder. None of the technical features are common to or shared with the technical features found in Groups XI – XII.

**Groups XI and XII:** Group XI comprises technical features such as receiving means connected to said network and receiving petition information of a suit with respect to said service transmitted via said network. None of the technical features are common to or shared with the technical features found in Groups XI – XII.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action lack unity of invention for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has not contacted the applicant for election over telephone due to the complex nature of the election/restriction requirement (see MPEP §812.01 (R-3)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

SMC